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CHANG, VICTOR S

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PANU K. ZOLLER and EUGENE G. HENNEN

Appeal 2010-008798
Reissue Application 10/817,439
Patent 6,365,254
Technology Center 1700

Before MICHAEL P. COLAIANNI, BRADLEY R. GARRIS, and
KAREN M. HASTINGS, *Administrative Patent Judges*.

HASTINGS, *Administrative Patent Judge*.

DECISION ON APPEAL¹

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final decision rejecting claims 1-53 and 55. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We AFFIRM.

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

Claim 1 is illustrative of Appellants' invention:

1. An adhesive tape assembly comprising:

a double-sided adhesive tape comprising:

a front adhesive side comprising a heat-activated adhesive layer, and

a back adhesive side comprising a pressure-sensitive adhesive layer; and

a release liner comprising:

a front liner side comprising a release layer in contact with, bonded to and removable from said pressure-sensitive adhesive layer, and

a back liner side comprising a roll stability layer which contacts said heat-activated adhesive layer when said adhesive tape assembly is formed into a roll, said roll stability layer comprising an ethylene vinyl acetate.

The Examiner maintains, and Appellants appeal, the following rejections under 35 U.S.C. § 103(a):

1) claims 1-3, 7-9, 22-24, 31, 32, 35, 38, 40-42, and 47-50 as unpatentable over Johnson 924²;

2) claims 4, 5, 43, 44, and 55 as unpatentable over the combined prior art of Johnson 924 and Reinders³;

3) claims 6, 10-21, 25-30, 33, 34, 36, 37, 39, 45, 46, 51-53 as

² US 5,178,924 issued Jan. 12, 1993.

³ US 6,037,028 issued Mar. 14, 2000.

unpatentable over the combined prior art of Johnson 924 and Johnson 995⁴;

FIRST MAIN ISSUE ON APPEAL

Appellants state that claims 1-3, 7-9, 31, and 32 stand or fall together with claim 1 (Br. 13). Appellants also rely upon the same arguments presented for this first identified claim grouping for claims 22-24, 35, 38, 40-42, and 47-50 (Br. 19-20). Thus, we select independent claim 1 as the representative claim on which our discussion will focus for the first ground of rejection.

Did the Examiner err in determining that the claimed adhesive tape assembly would have been obvious over Johnson 924, because, as alleged by Appellants, the Examiner has not established that it would have been obvious to use the ethylene vinyl release material of Johnson 924 modified with a tackifier for use as the roll stability layer as an alternative to the ethylene/acrylic acid copolymers modified with a tackifier roll stability layer of Johnson 924 (*see e.g.*, Br. 13-15)?

We answer this question in the negative.

PRINCIPLES OF LAW

In assessing whether a claim to a combination of prior art elements would have been obvious, the question to be asked is whether the improvement of the claim is more than the predictable use of prior art elements according to their established functions. *KSR Int'l. Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007). The analysis need not seek out precise teachings directed to the specific subject matter of the claim, for it is proper to take account of the inferences and creative steps that a person of ordinary skill in the art would employ. *Id.* at 418.

⁴ US 5,167,995 issued Dec. 1, 1992.

ANALYSIS
with Factual Findings

We have thoroughly reviewed each of Appellants' arguments for patentability of claim 1. However, we are in agreement with the Examiner that the subject matter of claim 1 would have been obvious to one of ordinary skill in the art within the meaning of § 103 in view of the applied prior art. Accordingly, we will sustain the Examiner's first ground of rejection for essentially those reasons expressed in the Answer. We rely upon the factual findings and reasoning of the Examiner with respect to this first ground of rejection (Ans. 3-5, 7-11; Final Office Action pp. 2-3, 6) and add the following primarily for emphasis.

Appellants' contentions in the brief amount to an allegation that there is insufficient motivation to use the ethylene vinyl acetate (EVA) release material of Johnson 924 as the roll stability layer of Johnson 924 (*generally* Br). Specifically, Appellants argue that the Examiner has failed to establish that the EVA taught to be useful as a release layer would have been useful instead of ethylene acrylic acid (EAA) as the roll stability layer (Br. 13), that obviousness can not be based on the mere fact that the components at issue (i.e., EAA and EVA) are functional or mechanical equivalents for the release layer (Br. 14-15), and that the Examiner has improperly relied upon "common knowledge" in the art without any evidentiary support in the record. These arguments are of no persuasive merit for the reasons well stated by the Examiner in the Response to Argument section of the Answer (Ans. 7-10). We fully agree with the Examiner that Johnson 924 suggests that since one of its listed release copolymer materials (EAA) may be modified by a tackifier to provide a roll stability layer as needed, that it

would have been reasonably expected that another release layer material (that is, EVA) of Johnson 924 would likewise function as a roll stability layer when modified with a tackifier, “absent any evidence that EVA and tackifier are necessarily incompatible” (Ans. 8).

The Examiner also finds that “it is self-evident” that Johnson 924 suggests “that a tackifier is a friction enhancing agent, which is result effective in providing desired level of friction to a release material”, such that no further evidentiary support is needed from the Examiner (Ans. 10; *see also* Ans. 9; Johnson 924 at col. 4-5). Notably, Appellants do not dispute this finding of the Examiner, as no responsive brief has been filed.

Furthermore, “[a] person of ordinary skill is also a person of ordinary creativity, not an automaton.” *KSR* at 421. The Examiner’s position is reasonable in view of the applied prior art, and Appellants have not provided any convincing technical reasoning nor evidence that one of ordinary skill in the art would not have, using no more than ordinary creativity, successfully used ethylene vinyl acetate modified with a tackifier as the roll stability layer of Johnson 924 (*generally* Br.).

Appellants rely upon the arguments presented for the first rejection, and do not present any additional arguments specific to any of the claims (claims 4, 5, 43, 44, and 55) rejected in the second ground of rejection (Br. 20).

Accordingly, the evidence as a whole supports the Examiner’s conclusion of obviousness, and on the record before us, we sustain the § 103 rejections of claims 1-5, 7-9, 22-24, 31-32, 35, 38, 40-44, 47-50, and 55 as

maintained by the Examiner.⁵

ADDITIONAL ISSUES ON APPEAL

Appellants separately argue claims 10-14, 25-28, 36, 37, 39, 45, and 51-53, all included in the third ground of rejection, which either functionally require that the EVA has a sufficiently low content of vinyl acetate such that the roll stability layer does not block with said heat activated layer (claims 10 and 45) or recite specific levels of vinyl acetate content (claims 11-14, 25-28, 36, 37, 39, and 51-53) (See Br. 21-23, 26)⁶.

We find Appellants' contention that there is no guidance given as to the vinyl acetate content of Johnson 924 unavailing, since it would have been understood by one of ordinary skill in the art that it would have been undesirable for the EVA release material to block with the heat activated layer of Johnson 924. Consequently, we agree with the Examiner that "selecting a workable vinyl acetate content in EVA" would have been within the level of skill in the art (Ans. 10; *see also* Ans. 6).

Appellants next argue that the Examiner has taken an unreasonable interpretation of independent claims 15 and 29, which each require an anti-blocking agent in the roll stability layer, by stating that since claims 16 and 30 which are respectively dependent thereon recite "up to 5%", the amount may include zero (*see, e.g.*, Ans. 11). Claim 46 likewise requires the

⁵ Only those arguments actually made by Appellants have been considered in this decision. Arguments which could have been made, but Appellants chose not to make, have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2008).

⁶ Appellants state that claims 11-14, 25-28, 36, 37, 39, and 51-53, "will stand or fall together" Br. 22. Since the same reasoning applies to claims 10 and 45 which functionally recite the amount of vinyl acetate, we likewise treat them in this claim grouping.

presence of an anti-blocking agent in the roll stability layer (Br. 26).

Although we agree with Appellants that this is an unreasonable claim interpretation, we must note that Appellants have not disputed the Examiner's finding that Johnson 995 exemplifies the known use of anti-blocking material in a release liner, nor have Appellants challenged the Examiner's conclusion that it would have been obvious

to incorporate a workable amount of antiblocking agent in the release liner, as taught by Johnson 995, in the invention of Johnson 924, motivated by the desire to provide for releasability of the release liner from the heat activated adhesive while maintaining roll stability.

(Ans. 6)

Notably, the anti-block material described in Johnson 995 is the same anti-blocking agent described by Appellants in their disclosure (100063 Anti-block from Ampacet Corporation; *compare* Johnson 995 at col. 11 l. 24 to Appellants' disclosure at col. 6, ll. 5-16). Accordingly, the use of an anti-blocking agent in the roll stability layer (which is a part of the release liner of Johnson 924) appears to be no more than the predictable use of a known prior art element for its known function.

Accordingly, we agree with the Examiner's ultimate conclusion of obviousness with respect to these claims.

Finally, Appellants separately argue independent claim 21 (Br. 25, 26). Appellants, however, have not shown any error in the Examiner's position that it would have been obvious to optimize the roll diameter within the claimed "at least about 20 times" the width of the tape of a roll tape containing a roll stability layer as taught in Johnson 924. Notably, Appellants' own disclosure admits that roll diameter to width ratios of this

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magnitude (about 49.7, 60 and 33) have been employed in “prior adhesive tape assemblies” (col. 9, ll. 37- 50).

DECISION

We affirm the Examiner’s § 103 rejection of claims 1-3, 7-9, 22-24, 31-32, 35, 38, 40-42, and 47-50 as unpatentable over Johnson 924.

We affirm the Examiner’s § 103 rejection of claims 4, 5, 43, 44, and 55 as unpatentable over the combined prior art of Johnson 924 and Reinders.

We affirm the Examiner’s § 103 rejection of claims 6, 10-21, 25-28, 30, 33, 34, 36, 37, 39, 45, 46, and 51-53 as unpatentable over the combined prior art of Johnson 924 and Johnson 995.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(v).

AFFIRMED

sld

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